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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/874,940	06/04/2001	Bruce M. Ruana	RUANA-001	3502

7590

12/15/2004

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EXAMINER
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MAYO, TARA L

ART UNIT	PAPER NUMBER
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3671

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/874,940

Applicant(s)

RUANA, BRUCE M.

Examiner

Tara L. Mayo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims.**

- 4) ☒ Claim(s) 11,23,34,46,57,69 and 74-79 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11,23,34,46,57,69 and 74-79 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05 November 2004 has been entered.

#### ***Claim Rejections - 35 USC § 112***

2. All prior rejections of the claims under 35 USC §112, first paragraph have been overcome by the response filed 05 November 2004.

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 11, 34, and 57 are rejected under 35 U.S.C. 102(e) as being anticipated by Kobe et al. (U.S. Patent No. 6,610,382 B1).

Kobe et al. '382, as seen in Figure 1, disclose a grip (20) for releasable adhesion to a hand support system comprising:

with regard to claim 11,

a skin layer (21) having a top surface (the plane within which lie the tops of elements 26) and a bottom surface (25), wherein said top surface is flat;

a 4-way stretchable material (22; col. 4, lines 16 through 17 and 25 through 41) layer with a stretchable top surface and stretchable bottom surface, said top surface of said stretchable layer adhered permanently to said bottom surface of said skin layer; and

a releasable adhesive (34; col. 4, lines 54 through 56) disposed on said bottom surface of said 4-way stretchable layer, wherein said 4-way stretchable material comprises polyester.

Kobe et al. '382, as seen in Figure 8, disclose a system (100) for providing a releasably attachable grip on a railing comprising:

with regard to claim 57,

a railing having a length and cross-sectional circumference;

a 4-way stretchable layer having an inner layer and an outer layer and wherein said 4-way stretchable layer comprises polyester, said inner surface of said 4-way stretchable layer releasably adhered to said railing; and

a skin layer wrapped around said 4-way stretchable layer, said skin layer having an outer surface and an inner surface, said inner surface of said skin layer permanently adhered to said outer surface of said 4-way stretchable layer.

With regard to claim 34, the method steps recited therein are inherent to the method of making the device disclosed by Kobe et al. '382.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 23, 46, and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobe et al. (U.S. Patent No. 6,610,382 B1).

Kobe et al. '382, as seen in Figures 1 and 8, disclose all of the features and method steps of the claimed invention with the exception(s) of:

with regard to claims 23, 46, and 69,

a backing layer having a top surface and a bottom surface, the top surface of the backing layer permanently adhered to the bottom surface of the skin layer.

Kobe et al. '382 expressly teach the possibility of multiple backing layers (col. 2, lines 39 through 42, and col. 4, lines 5 through 8).

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With regard to claims 23 and 69, it would have been obvious to one having ordinary skill in the art of grips at the time the invention was made to include an additional backing layer to impart desired strength to the skin layer of the device.

With regard to claim 46, the method steps recited therein are inherent to the method of making the device disclosed by Kobe et al. '382 as modified above.

7. Claims 74 through 79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobe et al. (U.S. Patent No. 6,610,382 B1) in view of Oseroff et al. (U.S. Patent No. 3,848,480).

Kobe et al. '382 disclose all of the limitations of the claimed invention with the exception(s) of:

with regard to claims 74 through 79,

a luminescent presence in the skin layer.

Oseroff et al. '480, as seen in Figures 1 through 6, show a grip and expressly teach the desirability of a luminescent handgrip for safe handling of a railing in the dark (col. 5, lines 35 through 42).

With regard to claims 74 through 79, it would have been obvious to one having ordinary skill in the art of grips at the time the invention was made to modify the device shown

by Kobe et al. '382 such that it would include a luminescent presence in the skin layer. The motivation would have been to provide for safe handling in the dark.

### *Response to Arguments*

8. Applicant's arguments filed 05 November 2004 have been fully considered but they are not persuasive.

With regard to the top surface of the skin layer being flat, Kobe et al.'382 in Figure 1 teach the newly added limitation. Specifically, the top surface of the skin layer, as defined by the top of the projections (26), is flat. Furthermore, the Specification as originally filed fails to disclose any criticality or synergistic result attributable to the claimed flat top surface of the skin layer.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the seal) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, in view of the teaching by Kobe et al. '382 for a grip including projections having minimal height (28; col. 9 lines 11 through 19), the device shown by the same would be capable of functioning the same as the claimed invention (i.e., forming the seal) including the undergoing the application of ink, graphics, adhesives, and other materials thereto.

In response to Applicant's statements that the backing layer (22) shown by Kobe et al. '382 serves "to resist stretching", the Examiner notes the reference (col. 3, line 67 through

col. 4, line 1) actually states "*may* serve to ... stretching." Therefore, a backing layer comprising a stretchable material is within the scope of the device disclosed by Kobe et al. '382. Additionally, Kobe et al. '382 expressly teach the backing layer being made of polyester (col. 4, lines 16 through 17 and 25 through 41). It is further noted that Applicant discloses MYLAR (an extremely low-stretch material) as a suitable polyester material from which to make the 4-way stretchable material layer.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tara L. Mayo whose telephone number is 703-305-3019. The examiner can normally be reached on Monday through Friday 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas B. Will can be reached on 703-308-3870. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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12 December 2004

  
ROBERT E. PEZZUTO  
PRIMARY EXAMINER